

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the attached Certified English Translation of the Priority Document, the two Terminal Disclaimers, Claim Amendments and the following remarks.

Claims Status

Claims 1, 5-14, 16-19 and 21-26 are pending in this Application.

Claim 1 has been amended herein to recite that the toner particles comprise a resin prepared by poly addition or polycondensation reaction. Support for this limitation can be found in Claim 11. Claim 1 has also been amended to recite the slope of circularity compared to the equivalent circle diameter for the toner particles. Support for this limitation can be seen in Claim 3. Claim 1 has also been amended to delete the phrase "situation in the vertical direction" from Claim 1.

Because of the amendments made to Claim 1, Claim 3 has been canceled and Claims 5, 6 and 11 amended.

Claim 20 has also been canceled herein.

Priority Document

Applicants have attached a Certified English Translation of the Priority Document in order to perfect their priority and take their date back to March 6, 2003. The attached Priority Document supports the claims as follows:

<u>U.S. Claim</u>	<u>Priority Document (paragraphs)</u>
1	16-18
5, 6, 22	36
7	49
8,9, 11, 23, 24, 26	109
10, 13, 25	112
12, 14, 16, 17	32-34, Fig. 3
18	37
19	1, 27
21	16-18, 36

Respectfully, in view of the English Translation of Applicant's Priority Document, Applicants have perfected their date of priority. This will be used in responding to a number of the Office Action as will be discussed in more detail below.

Rejection Based on 35 USC 112

Claims 1, 3, 5-13 and 16-20 had been rejected based on the wording in Claims 1 and 20 of "in the vertical direction". Additionally, Claim 20 had been rejected based on the phrase "separates paper dust or toner granules" because it was not clear what the paper dust or toner granules were separated from.

Claim 20 has been canceled herein and Claim 1 has been amended herein to delete the phrase "in the vertical direction".

It will be noted that the paper dust or toner granules are separated from the toner so as to reuse the toner.

Respectfully, in light of the amendments made to Claim 1, the cancellation of Claim 20, the rejection based on 35 USC 112, is overcome.

Prior Art Rejection Based on Taffler

Claim 20 had been rejected as being anticipated by Taffler. Claim 20 has been canceled herein.

Prior Art Rejection based on JP '813 and Ohmura, Matsushima and Hayashi

Claims 14, 21 and 23-26 had been rejected as being unpatentable over a combination of JP '813 with Ohmura, Matsushima and Hayashi.

As noted by the Examiner, both Ohmura and Matsushima have U.S. filing dates prior to the Japanese Priority Date of this Application but have Publication Dates after the Japanese Priority Date of this Application. Applicants have submitted a Certified English Translation of the Priority Document in order to perfect their priority and submit that Ohmura and Matsushima are now Prior Art only in accordance with 102(e).

Furthermore, because this is a 103 rejection and Ohmura and Matsushima are Prior Art under 102(e), Applicants hereby make the following statement in accordance with 103(c) to remove Ohmura and Matsushima as Prior Art:

"The subject matter of Ohmura and Matsushima and the claimed Invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person" (35 USC 103(c)).

Respectfully, Applicants have removed Ohmura and Matsushima as effective Prior Art under 103 and, thus, the rejection of unpatentability based on Ohmura and Matsushima has now been overcome.

Prior Art Rejection Based on Taffler and Ohmura

Claims 1, 3, 8-10 and 16-19 have been rejected as being unpatentable over a combination of Taffler and Ohmura.

In light of the statement made above, Ohmura is no longer Prior Art under 103(c) and, thus, the rejection based on the combination of Taffler and Ohmura is now moot.

Prior Art Rejection Based on the combination of Taffler, Ohmura, Matsushima and Hayashi

Claims 5 and 11-13 had been rejected based on the combination of Taffler, Ohmura, Matsushima and Hayashi.

In light of the fact that Ohmura and Matsushima are no longer suitable Prior Art under 35 USC 103, it is respectfully submitted that this rejection has now been overcome.

Prior Art Rejection based on a combination of Taffler and Ohmura.

Claims 1, 5, 8, 9, and 16-19 had been rejected as being unpatentable over a combination of Taffler and Ohmura.

Claim 1 has been amended to add the limitations of Claim 3 and it is respectfully submitted that this rejection has now been overcome.

Prior Art Rejection Based on Taffler and JP '333

Claims 1, 5, 8, 9, and 16-19 had been rejected as being unpatentable over a combination of Taffler and JP '333. Claim 1 has been amended herein to add the limitation of Claim 3 and it is respectfully submitted that this rejection has now been overcome.

Prior Art Rejection Based on a Combination of Taffler, JP '333 and Misawa

Claims 6 and 7 had been rejected as being unpatentable over a combination of Taffler, JP '333 and Misawa.

Claims 6 and 7 are dependent upon Claim 1 and Claim 1 has been amended to add the limitations of Claim 3. In light of the amendments made herein, it is respectfully submitted that the rejection to Claims 6 and 7 is now overcome.

Double Patenting Rejection

The Examiner put forward four different non-statutory obviousness-type double patenting based on either Matsushima '952 or Ohmura '126. Enclosed herewith are Terminal Disclaimers for both of these Patents. Respectfully, the various double patenting rejections have now been overcome based on the enclosed Terminal Disclaimers. The fees associated therewith are being paid concurrent with the filing of this Response.

One Month Extension of Time

Applicants hereby petition for a one month extension of time for responding to the outstanding Office Action from September 29, 2007 to October 29, 2007 and submit with this Response the necessary fee in order to pay for such an extension of time.

Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to Debit Account #02-2275.

Conclusion

In view of the foregoing, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,
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Attached: Certified English Translation of Priority
Document

Terminal Disclaimer for '126
Terminal Disclaimer for '952